

Notice of Allowability

Application No.

09/690,677

Examiner

Ronald D Hartman Jr.

Applicant(s)

TAYLOR, BILLY P.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/29/2004.
2. ☒ The allowed claim(s) is/are 1-21.
3. ☒ The drawings filed on 16 October 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 1/15/04,7/30/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. Claims 1-21 are presented for further examination.

Allowable Subject Matter

2. Claims 1-21 are allowed.

As per claims 1-21, specifically independent claims 1, 7 and 13, the prior art of record fails to teach or adequately suggest a method for translating a first version of a paper into a second version of the paper. It is noted that several systems were located that disclose the use of personalized newspaper systems and methods, however, no particular reference of combination of references could be located that specifically taught the claimed system claimed by way of at least pending claims 1, 7 and 13. This is explained in further detail below:

- the first limitation of the claimed system provides for an actual physical paper (i.e. newspaper) to be stored as a first version wherein the first version has first displayable content that is capable of being displayed in a particular location within the paper. This step is not believed to be novel as newspapers have been scanned into digital forms and converted to online forms (i.e. HTML), so that readers may view their contents from online (i.e. using the Internet or World Wide Web), for quite some time. Also the use of newspaper templates has been known for quite some time and these templates are utilized by an individual reader for the purpose of allowing for a customized newspaper to be delivered to the reader for eliminating unwanted section of the newspaper.

- the second limitation forms the basis for the allowance of the instant claims. That is, the translation of the first version into the second version, ***wherein the second version replaces the first displayable content at the particular location with second displayable content at the same location*** (emphasis added) is not taught in the prior art of record. This feature is best represented by way of Figures 3r and 3s. In these figures an advertisement for Cartier (Figure 3r) is the first displayable content and an advertisement for Wempe (Figure 3s) is the second displayable content.

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Based on the preferences of the reader, the claimed invention of at least claims 1, 7 and 13 would provide a translated version of the Figure 3r to the reader, this version being Figure 3s if the reader had previously expressed interest in Wempe or watches in general, per se.

This system is not taught in the prior art since most previous systems use templates to organize the layout of the newspaper and the templates are usually stored on a server, not an actual digitized version of the physical paper.

Therefore, for at least these reasons, the aforementioned claims (claims 1, 7 and 13) are believed to be allowable over the prior art of record.

3. It is noted that the closest available prior art appears to be issued:

- Miyasaka et al., U.S. Patent No. 6,766,362. This system teaches a similar system and method as that of the pending claims, however, the filing date of the Miyasaka reference is not before the filing date of the instant application, and therefore is not considered applicable prior art.

- Larson, U.S. Patent Application Number US 2002/0188635 A1. This system and method is for use in forming personalized advertising in digital newspapers. However, the filing date of Larson negates this reference from being applied as prior art since it falls after the effective filing date of the instant application;

- Kent, U.S. Patent Application Number US 2002/0040374 A1. This system and method is for personalizing and customizing publications that are accessed over the Internet. However, the filing date of Kent negates this reference from being applied as prior art since it falls after the effective filing date of the instant application; and

- Nehab et al., U.S. Patent No. 6,029,182. This system is for creating customized hypertext documents for use over the Internet with a preferred embodiment being directed towards customizing and personalizing electronic newspapers. This system however, does not teach the novel aspects of the claims 1, 7 and 13, as described above; and

- Stern et al., U.S. Patent Application Publication Number US 2003/0200507. This system and method teaches a way by which a reader can have

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personalized newspapers. This system teaches the conversion of the newspaper into different formats. However, the system and method of Stern does not anticipate the pending claimed invention since it's effective filing date (6/16/2000) was filed after the effective filing date of the instant application (6/1/2000) and for this reason, Stern is not considered to be applicable prior art.

gus/ok

The aforementioned references all teach systems and methods for personalizing a newspaper. However, none of the aforementioned systems of methods teach a physical newspaper having its layout determined so that each reader will see basically the same newspaper as one that is published using traditional-printing techniques. This allows the reader to experience a newspaper with the same "look and feel" as the one printed, the exceptions to the layout being in the form of content that is individually tailored to a particular reader. This system is not disclosed by any of the prior art since the prior art systems, listed above, only teach that the reader individually tailors each newspaper so that content, that the reader is interested in, appears in the newspaper. The prior art is silent with respect to having the newspaper. The prior art is silent with respect to having the personalized newspaper also look the same as a mass produced printed paper, which is readily available to the public.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is 703-308-7001. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.

Examiner

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A handwritten signature in black ink, appearing to read "Anthony Knight", is written over a faint, circular official stamp.

Anthony Knight
Supervisory Patent Examiner
Group 3600